

REMARKS

Claims 1-16 are now pending in this application for which applicant seeks reconsideration.

Amendment

Claims 17-20 have been canceled and independent claims 1, 5, 9, and 13 have been amended to positively define that the digital contents are music contents, and to improve their clarity. In this respect, these claims call for receiving a modified digital music content from one of the users via the first user terminal together with status information indicating that the received modified digital music content is subject to the legal protection and identifying a content proprietor of one digital music content that represents a music piece that has been modified as the modified digital music content by the one user, who is different from the identified content proprietor. No new matter has been introduced.

§ 112 Rejection

The examiner rejected claims 1, 5, 9, and 13 under 35 U.S.C. § 112, first paragraph, because the claim language "wherein the secondary work by the one user is a modified version of a digital content provided by the content proprietor" is deemed to introduce new matter. Although this rejection has been rendered moot as the claims no longer recite the language "secondary work," applicant nonetheless traverse this rejection because by definition, a "secondary work" means work by another that has been revised. See for example (not attached) note 28 of *COPYRIGHT LAW: THE RELEVANCE OF BAD FAITH TO A FAIR USE ANALYSIS*, NXIVM Corp. v. Ross Institute, 364 F.3d 471 (2d Cir. 2004), by Melisa San Martin, Journal of Technology Law & Policy, Volume 9, Issue 24, December 2004 (*A secondary work is "transformative" of the original if it "adds something new, with a further purpose or different character" and in doing so, creates a new meaning, referring to Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994).*

Art Rejection

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yamanaka (USPGP 2001/0016834) in view of the ImgRadio article (*Imagine Radio Debuts a New Generation of Customized Radio*). Applicant traverses this rejection because the combination urged by the examiner still would not have disclosed or taught allowing MODIFIED music content, namely, a modified music piece (e.g., song), to be distributed as set forth in independent claims 1, 5, 9, and 13.

Independent claims 1, 5, 9, and 13 each call for registering a modified digital music content. See Fig. 8 of the present disclosure. In this respect, these claims call for receiving a modified digital music content from a user via a first terminal (i.e., one of the plurality of user terminals) together with status information indicating that the received modified digital music content is subject to the legal protection and identifying a content proprietor of one digital music content representing a music piece that has been modified as the modified digital music content by the one user, who is different from the identified content proprietor. In other words, the modified digital music content is a modified version of the one digital music content owned by the proprietor, who is not the one user. After registering the received modified digital music content, a request for delivery of the registered modified digital music content from a second user terminal (i.e., another of the plurality of user terminals) can be made. The registered modified digital music content is delivered to another user via the second user terminal when the request from the another user over the computer network is received.

The undersigned attempted to hold a formal telephonic interview, but merely resulted in a brief informal discussion relating to what ImgRadio article discloses. Based on the discussion, it appears that the examiner is interpreting ImgRadio's radio station (playlist) created by one user to correspond to a secondary work because it includes songs by various artists that are different from the original CDs. In other words, although the ImgRadio article does not disclose allowing registration of a modified song, because the playlist in itself constitutes a secondary work, the examiner deems that the combination would have taught the claimed invention.

Even if the ImgRadio's playlist or radio station were to be a secondary work, it still does not correspond to a modified music piece (e.g., song), and ImgRadio would not have disclosed or taught allowing the user to upload or submit modified music piece or song to allow another user to receive the modified song. In other words, the combination would not have taught allowing the user to submit and register a modified digital music content, or allowing another user to receive the modified digital music content, while protecting the proprietor of the original digital music content, as set forth in independent claims 1, 5, 9, and 13.

Request for Interview

Applicant requests a telephonic interview in due course after the examiner has had the opportunity to review the present amendment. Although the undersigned will contact the examiner to schedule an interview, the undersigned would appreciate if the examiner would contact the undersigned after reviewing the present amendment.

Conclusion

Applicant submits that claims 1-16 patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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08 JUNE 2008

DATE

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REG. NO. 34,079 (RULE 34, WHERE APPLICABLE)

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